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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/698,651	10/30/2003	Bennett Johnston	JOHN-101/USA/P	3757

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EXAMINER
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PIERCE, WILLIAM M

ART UNIT	PAPER NUMBER
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3711

DATE MAILED: 06/02/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/698,651

Applicant(s)

JOHNSTON, BENNETT

Examiner

William M. Pierce

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 4/30/04.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-19 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

WILLIAM M. PIERCE  
PRIMARY EXAMINER

## Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 1.
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_\_.

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**DETAILED ACTION**

**DETAILED ACTION**

***Claim Rejections - 35 USC § 101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-19 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

While a "process" is well recognized as statutory subject matter, not every process falls within the "useful arts" under 101. *Cochrane v. Deener*, 94 U.S. 780, 788 (1877) define "a process is...an act or series of acts, performed upon the subject matter to be transformed and reduced to a different state or thing.

In the instant case, the claims do not require the manipulation of an apparatus, do not result in a concrete and tangible result and fail to transform the subject matter to a something different than existed before the steps were performed.

Another of the subject matters courts have found to be outside the four statutory categories of invention is abstract ideas. See, e.g., *Rubber-Tip Pencil Co. v. Howard*, 87 U.S. (20 Wall.) 498, 507 (1874) ("idea of itself is not patentable, but a new device by which it may be made practically useful is"); *Mackay Radio & Telegraph Co. v. Radio Corp. of America*, 306 U.S. 86, 94, 40 USPQ 199, 202 (1939).

In the instant case, the key is that there exists no "concrete or tangible result. In order for and "abstract idea" to be statutory subject matter analogous to a method of doing business it must produce a useful, concrete and tangible result. The examiner does not dispute the usefulness requirement. Games cannot be disputed for their usefulness in entertainment. However, the result must also be "concrete" and "tangible". By definition something which is concrete is "having a material, perceptible existence; of, belonging to, or characterized by things or events that can be perceived by the senses; real; actual and something which is tangible is "that can be touched...having actual form and substance". In the instant invention the results are intangible. The episodic memory and the semantic memory systems are different and used differently from person to person. While applicant's specification points to results of "playfulness", these results are considered subjective and not concrete and tangible as required. In addition there exists no evidence of record that supports any concrete and tangible results. As such, absent of any evidence of any "tangible results", the claims would remain rejected under 101.

In another perspective, the claims are drawn to a mere arrangement of printed matter in the form or "instructions". Though seemingly a "manufacture," such is not within the statutory classes. See *In re Miller*, 418 F.2d

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1392, 164 USPQ 46 (CCPA 1969); Ex parte Gwinn, 112 USPQ 439 (Bd. App. 1955); and In re Jones, 373 F.2d 1007, 153 USPQ 77 (CCPA 1967).

Moreover, "memory" in the broadest sense is a scientific principle that exists in nature. Such things occurring in nature, which is substantially unaltered, is not a "manufacture". Ex parte Grayson, 51 USPQ 413 (Bd. App. 1941). And a scientific principle, divorced from any tangible structure, can be rejected as not within the statutory classes. O'Reilly v. Morse, 56 U.S. (15 How.) 62 (1854). Broadly here the instant claims can be viewed as an attempt to gain the rights to exclude based on the use of memory in a question and answer game. Such human memory exists in nature and under scientific principle and is considered non-statutory subject matter.

Further the disclosed invention is inoperative and therefore lacks utility. The episodic memory and the semantic memory systems are different and used differently from person to person. Persons do not have control over which systems of memory they resort to when facing a question or a problem. It is usually a combination memory systems in varying degrees depending upon the person. See the reference to Human Memory attached to this office action. For example, the question may be to list as many "rivers" as possible (from applicant's fig. 2). A player may answer from episodic memory based a rafting trip or his semantic memory based on his geography course. With regard to question and answer games in general, a player inherently uses all combinations of memory systems stimulated to a varying and unique degree that are necessary for them to use to formulate the best possible answer to the question or task before them. Another example would be from applicant's fig. 3, "the best vistas" could come from pictures in a history book or a past vacation depending upon the person and their state of mind when face with the question. To say that a particular question will only stimulate one, two, three or a combination of memory systems is not operative since such is dependent upon the person and their memory functions and not on the question.

#### ***Claim Rejections - 35 USC § 112***

Claim 1-19 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. One cannot determine if claims 1-12 are drawn to a method or apparatus. Applicant must positively recite to which of the statutory classes the claims are to be drawn. As to claims 13-19, the claims lack any positive physical steps that can be performed such that one can determine the metes and bounds of the claims. Steps such as selecting and responding that occur only mentally are not physical steps that render the claim clear in scope. One cannot determine the metes and bounds of

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the terms "competitive", "non-competitive", "judgment free" and "a structured relationship" as used in the claims. Such terms are subjective without a definite standard.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Henry 4,714,255. in view of Alexander 6,279,909

As to claims, Henry shows a game board of intersecting first and second paths in combination with a plurality of collections of instructions in fig. 4 that stimulate the human memory. Inherently the player uses all of his memory systems, short-term, semantic and episodic memory systems, available to him based upon his individual ability in order to answer the question. Alternatively, while Henry factual trivia question, Alexander teaches that a mix of tasks, questions and actions can be in a trivia type game. To have added tasks such as that taught by Alexander would have been obvious in order to make the game more interesting to the players by offering a more variety of questions. With respect the applicant's use of the term "instructions" per se, broadly it has been held that the addition of instructions for how to use a device cannot impart patentability. See *In re Ngai* (5/13/04)(Michel, Garjarsa, Linn)(per curiam).

Further while Henry and Alexander fail to discuss the science behind the memory skills use in the answering of the game tasks, it has been clearly held that a property or a scientific explanation of the prior art's functioning does not negate the fact that the prior art inherently possessed the claimed element. "Insufficient prior understanding of inherent properties of a known composition does not defeat a finding of anticipation" *Atlas Powder Co. v. Ireco Inc.*, 19 F.3d 1342, 51 USPQ 2d 1943 (Fed. Cir. 1999).

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Was, Moore, Finch show games.

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Any inquiry concerning this communication and its merits should be directed to William Pierce at E-mail address [bill.pierce@USPTO.gov](mailto:bill.pierce@USPTO.gov) or at telephone number (571) 272-4414.

For **official fax** communications to be officially entered in the application the fax number is (703) 872-9306.

For **informal fax** communications the fax number is (703) 308-7769.

Any inquiry of a general nature or relating to the **status** of this application or proceeding can also be directed to the receptionist whose telephone number is (703) 308-1148.

Any inquiry concerning the **drawings** should be directed to the Drafting Division whose telephone number is (703) 305-8335.

  
WILLIAM M. PIERCE  
PRIMARY EXAMINER